

REMARKS

The Office Action mailed November 30, 2004 has been carefully considered. Applicants request that the Examiner consider the following remarks, and then pass the application to allowance.

Pending Claims

Claims 1-30, 32-34, 36-38 and 40-44 are pending. Claims 31, 35 and 39 have been previously cancelled.

Art Rejection

In the Office Action, claims 1-30, 32-34, 36-38 and 40-44 were rejected under 35 U.S.C. § 103(a) as being anticipated by Dodd (U.S. Pat. App. No. 6,633,849) in view of "Will Gift Lists Click?" (New York Times, New York, November 18, 1999 (hereafter "Wish Lists")). Applicants respectfully submit that because there is no teaching or suggestion to combine the references, the claims of the present application are allowable.

As understood, Dodd discloses a method and system for automatically forwarding a gift from a donor to a recipient with the ability of the recipient to exchange the gift if needed. (Dodd, Col. 1, lines 63-67). More specifically, as described in Column 3, lines 40-62 of Dodd, the gift giver accesses the gift server node as a website to select the product for the recipient. Once the product is selected, an electronic mail message is sent to the recipient indicating the type of gift. The recipient can view the product selection and determine whether he or she wants to accept, exchange, or forward the product. If the recipient accepts the

product, then the gift is sent. If the recipient wants to exchange the gift, then an electronic gift certificate is issued to the recipient. Alternatively, the recipient can forward the product to another recipient.

Wish Lists describes online gift giving registries whereby a recipient of a gift can indicate gift selections on the gift registry website. The wish list is stored at the registry site and a list creator alerts friends and family members that the user has created the list. Gift givers can go to the site and view the wish list. The gift givers purchase the gifts directly from the retailers.

Applicants respectfully submit that there is no teaching or suggestion to combine Dodd with Wish List as suggested by the Examiner. Specifically, Dodd teaches away from the combination because Dodd teaches a gift giver sending a gift directly to a recipient in order to facilitate exchange of the gift. On the other hand, Wish Lists teaches a gift giver receiving a message about a wish list. Combining Dodd with Wish List does not result in the invention as presently claimed because the gift giver does not have the capability for a gift recipient to request the type of gift to be given.

Dodd and Wish List cannot be combined because Dodd teaches the mechanics of how a gift giver transfers a gift. By combining Dodd with Wish List, the mechanics of the transfer would not work because Wish List teaches the recipient choosing the gift. On the other hand, Dodd teaches the gift giver choosing the gifts to give. Accordingly, the combination of Dodd and Wish List would be improper because the system of Dodd would not operate correctly. Specifically, Dodd would not be a system whereby the gift giver chooses the gift and the manner of giving. By combining Wish List with Dodd, the gift giver of Dodd gives up the option of choosing

the type of gift to give. Accordingly, the combination of Dodd and Wish List is discouraged because the operation of Dodd would be prohibited. Accordingly, Applicants respectfully submit that the combination of Dodd and Wish List is improper.

Conclusion


Applicants respectfully submit that independent claims 1, 8, 15, 22, 29, 33, 37 and 41 are in condition for allowance as are claims 2-7, 9-14, 16-21, 23-28, 30, 32, 34, 36, 38, 40, and 42-45 as being dependent upon a respective allowable base claim. As such, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance. Such allowance is respectfully requested.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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